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EXAMINER

WOODS, ERIC V

ART UNIT	PAPER NUMBER
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2628

DATE MAILED: 06/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/626,723

Applicant(s)

NAKANO ET AL.

Examiner

Eric Woods

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5,7-10 and 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,7-10 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on 17/1/2006 has been entered.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will

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the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Response to Arguments

Applicant's arguments, see Remarks pages 1-4, filed 17/1/2006, with respect to the rejection(s) of various claims under various statutes have been fully considered but are not found to be persuasive.

All rejections against claims 13-26 have been withdrawn since those claims were canceled.

Claims 1-2, 4-5, 7-10, and 12 stand pending.

The rejections of claims 1-2, 4-5, 7-10, and 12 do not stand withdrawn. Applicant has not demonstrated the criticality of the claimed range. Previously, applicant had claims that were broader in scope and encompassed all ranges – from 1 pixel movement to moving pixels the maximum size of the display. Applicant has since narrowed the claims. The prior art discloses, teaches, or fairly suggests the claimed range (e.g. moving the second or icon image around the screen) – that being the entire range of the screen.

The newest case from the Federal Circuit on this matter is *In re Geisler*, (CAFC 1997) 43 USPQ2d 1362. That case established that a prima facie case of obviousness could be rebutted if applicant can establish existence of unexpected properties in the claimed range (e.g. "unexpected results") or can show that the prior art taught away in any case from the claimed invention. In *Geisler*, the court held that applicants had a burden to show unexpected results,

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where applicant claimed that a narrower range that overlapped prior art ranges produced better results. It does not matter that the subject matter in *Geisler* was the thickness of a film – the facts are sufficiently similar (range within a range, in this case) that the precedent applies. No evidence has been introduced into the record showing this to be the case. Indeed, applicant's own specification discusses that the goal of the invention is to have the image shift equally within all portions of such a range (1 to 5 pixels) so that the amount of shift is random (page 16, lines 9-22, emphasis lines 20-22).

Just because a range within a range is better, that does not prove anything, since one of ordinary skill in the art would be motivated to find the optimum range within a range. Indeed, as noted in MPEP 2144.05, *In re Peterson*, 315 F.3d at 1330, 65 USPQ2d at 1382 ("The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages.").

Furthermore, as the Court noted in *Geisler*, there is nothing in the record – particularly in applicant's responses – that claims or suggests unexpected results. No test data was supplied, no affidavits have been sent, and otherwise the record is formally deficient of any such suggestion or argument. No arguments have been presented that the prior art teaches away in any material way.

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention

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without specifically pointing out how the language of the claims patentably distinguishes them from the references. Specifically, applicant alleges that the invention is patentable over the prior art references without specifically pointing out how it differentiates itself from them. For example, the prior art presented (PIP on television) was presented as being **modified** by the Abe reference, which clearly provides motivation for causing such windows to move around.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant has not adequately addressed the fact that the rejections are not based on one reference, but rather on the combination. Applicant alleges on page 3 of Remarks that the primary citations "are not read to successively determine a plurality of different display positions ..." This amounts to a mere allegation that the reference is patentable. Lastly, one line is addressed to the Abe reference, which is the critical portion of the rejection under 35 USC 103(a), providing the teaching of the key inventive feature. Applicant merely states that these references do not teach that limitation.

Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

Finally, applicant did not dispute examiner's assertion that claims 1 and 9 stand and fall together. As such, applicant has had an adequate chance to respond but failed to do so. Therefore, for purposes of appeal, applicant has already conceded this point.

Applicant has not, at any point during prosecution, argued that claim 9 seeks protection under 35 USC 112, sixth paragraph. As required by *In re Donaldson*, this paragraph serves as a statement that although the claim recites "step for", the claim fails the second and third prongs of the required test. The language present, although functional, does not rise to the level required by the second prong of *Donaldson*. The step limitation is clearly modified by adjectives, e.g. "determining step for determining..." that clearly establish functional limitations on their own, and the steps are further modified by wherein clauses, which therefore modify any specific act(s) recited by the "step for" limitations.

Under claim 9, the input step does not match to any specific acts recited in the specification. Nothing in the drawings illustrates a specific act. Finally, the modifier "input" provides sufficient functional description that it does not invoke 112 6th paragraph. *Cole v. Kimberly-Clark Corp.*, 102 F.3d 524, 531, 41 USPQ2d 1001, 1006 (Fed. Cir. 1996) (holding "perforation means...for tearing" does not invoke 35 U.S.C. 112, sixth paragraph, because the claim describes the structure supporting the tearing function (i.e., perforation). See MPEP 2181/)

The "determining step" is modified by a "wherein ..." clause thusly showing that it is **not** covered under the purview of 35 USC 112, sixth paragraph, because the specified act(s) must be capable of standing alone, and the wherein

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clause for the determining step then recites further structure, thusly removing it from the purview of 35 USC 112, sixth paragraph (see MPEP 2181 -- *Rodime PLC v. Seagate Technology, Inc.*, 174 F.3d 1294, 1303–04, 50 USPQ2d 1429, 1435–36 (Fed. Cir. 1999) (holding “positioning means for moving” does not invoke 35 U.S.C. 112, sixth paragraph, because the claim further provides a list of the structure underlying the means and the detailed recitation of the structure for performing the moving function removes this element from the purview of 35 U.S.C. 112, sixth paragraph); *Cole v. Kimberly-Clark Corp.*, 102 F.3d 524, 531,

The final recitation of “display control step” further describes the acts entailed by the step and removes it from the purview of 35 USC 112, sixth paragraph, as well, as described above.

Therefore, the claim is validly treated as a generic method.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ward and Abe in view of Sumikawa (US 6,040,817 A).

As to claims 1 and 9,

An image processing apparatus, comprising:

-Input means for inputting first image data and icon image data; (Ward teaches in Fig. 1 the use of a display device in [0028] that could be a television or PC monitor, wherein it takes in video from cable television or the like [0029], and in Fig. 1 in the upper left hand corner there is a PIP (picture-in-picture) window 12 clearly labeled as showing video, and the other windows show other content and/or image data)(Sumikawa teaches the use of input means, e.g. a mouse and/or other pointing device. There is also a screen containing multiple windows, see for example Figure 4.)

-Determining means for determining a display position of the icon image; and (The embodiment shown in Fig. 1 has fixed window position and size [0028], but other embodiments within Ward have user-adjustable window position, size, and content, see [0028-0029] and particularly [0168], where it is taught that the user can manipulate the various windows, especially the PIP window, as far as size and position, and that it can show multiple video streams simultaneously. The remote control shown in Fig. 2 can be used to position the various windows)(Sumikawa teaches that (4:35-50) the icon image (e.g. second window)

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is moved a position from the cursor, which comprises determining the display position of icon image)

-Display control means for superimposing one of the first image and the icon image on the other and displaying the first and icon images on a monitor such that the icon image is positioned in the display position determined by the determining means, (Other embodiments within Ward have user-adjustable window position, size, and content, see [0028-0029] and particularly [0168], where it is taught that the user can manipulate the various windows, especially the PIP window, as far as size and position, and that it can show multiple video streams simultaneously. The remote control shown in Fig. 2 can be used to position the various windows)(Sumikawa clearly shows main window, cursor, and secondary window in various positions as superimposed, again see Figure 4)

-Wherein the determining means determines successively a plurality of display positions different from each other as display positions of the icon image, and wherein the plurality of display positions are within a range of a predetermined number of pixels from a predetermined position. (Other embodiments within Ward have user-adjustable window position, size, and content, see [0028-0029] and particularly [0168], where it is taught that the user can manipulate the various windows, especially the PIP window, as far as size and position, and that it can show multiple video streams simultaneously. The remote control shown in Fig. 2 can be used to position the various windows as set forth in [0168], where the number of pixels for movement would be determined based on the user's selection.)(Sumikawa clearly shows in 4:35-50 and 4:65-5:5 that the window is

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positioned at a certain distance from the cursor in such a way that it does not cause an impediment to the operation.)

Abe clearly teaches in the abstract that the window is moved and sized dynamically based on random numbers, etc., as further illustrated in paragraphs [0008-0015] in the specification / detailed description where the first and second windows can each contain various images or similar and move around all over the screen, which is the teaching of the this claim, basically that a second window is moved around a first window based on a determining means, as recited in the specification that would contain a random number or similar.

While reference Ward teaches all of the limitations as set forth above, since the claim recites 'means' the Abe reference is incorporated because it performs essentially the same tasks, but under automatic program control rather than the user performing such a task, and obviously the techniques that allow the system of Abe to automatically resize and reposition windows could be used with the system of Ward such that the windows (e.g. main guide window and the PIP window) are resized, repositioned, etc. automatically until the user sees a combination that is ideal for their tastes and preferences. The Sumikawa reference clearly teaches that the second window is position at a certain other position with respect to the cursor and/or arrow position on the screen, where it would be obvious that the teaching of having the secondary window close but not at a point where it would be an impediment to viewing and/or operation would be obvious, and is well known to be beneficial (4:35-5:5).

Obviously, resizing the window would be an obvious variation, and the motivation for combination comes from the fact that an automatic method of performing a manual task is more efficient and more likely to quickly generate the desired results for the user than manually incrementing each window, which is obviously a tedious process. It would have been obvious to one of ordinary skill at the time the invention was made to modify Ward in light of Abe and Sumikawa, since Sumikawa teaches that the positioning of the secondary window within a certain amount of the main window is beneficial, which would yield the invention of applicant. Also, the incorporation of Sumikawa would allow for better and quicker positioning of the secondary window such that while it moved, it did not interfere with the user's viewing, as Abe possibly could.

The recited 'icon image' is not specifically defined by the specification and could be an OSD control menu, advertising, a window containing user tools (e.g. as in Sumikawa Figure 4C), or anything else. Examiner is interpreting it as broadly as reasonable (*In re Morris*).

Claims 1-3, 4-5, 7, and 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dimitrova in view of Abe and Sumikawa. Claim 9 is merely a method implementing apparatus of claim 1; rejections valid on one are equally valid on the other.

As to claims 1 and 9,

An image processing apparatus, comprising:

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-Input means for inputting first image data and second image data; (Dimitrova 1:5-37 teaches PIP (picture-in-picture) technology where a first and second video image are displayed on the same screen, which prima facie includes input means)

-Determining means for determining a display position of the second image; and (Dimitrova teaches that the PIP picture can be positioned and sized by the user and that this is well known in the art (1:5-37, emphasis on 1:32-37), and further that Dimitrova teaches automatic means for doing so – see the flowchart in Fig. 4, wherein Dimitrova teaches that the PIP moves around to regions of the video image with the least change so that it stays out of the way, and that the size and position of the PIP window are automatically adjusted – see for example steps 116, 128, and 130) (Sumikawa teaches the use of input means, e.g. a mouse and/or other pointing device. There is also a screen containing multiple windows, see for example Figure 4.) (Sumikawa teaches that (4:35-50) the icon image (e.g. second window) is moved a position from the cursor, which comprises determining the display position of icon image)

-Display control means for superimposing one of the first image and the second image on the other and displaying the first and second images on a monitor such that the second image is positioned in the display position determined by the determining means,

(Dimitrova teaches that the PIP picture can be positioned and sized by the user and that this is well known in the art (1:5-37, emphasis on 1:32-37), and further that Dimitrova teaches automatic means for doing so – see the flowchart in Fig.

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4, wherein Dimitrova teaches that the PIP moves around to regions of the video image with the least change so that it stays out of the way, and that the size and position of the PIP window are automatically adjusted – see for example steps 116, 128, and 130) (Sumikawa clearly shows main window, cursor, and secondary window in various positions as superimposed, again see Figure 4) -Wherein the determining means determines a display position of the second image such that the display position is changed within a range that is apart from the display position determined last time by a predetermined number of pixels. (Dimitrova teaches that the PIP picture can be positioned and sized by the user and that this is well known in the art (1:5-37, emphasis on 1:32-37), and further that Dimitrova teaches automatic means for doing so – see the flowchart in Fig. 4, wherein Dimitrova teaches that the PIP moves around to regions of the video image with the least change so that it stays out of the way, and that the size and position of the PIP window are automatically adjusted – see for example steps 116, 128, and 130) (Sumikawa clearly shows in 4:35-50 and 4:65-5:5 that the window is positioned at a certain distance from the cursor in such a way that it does not cause an impediment to the operation.)

Abe clearly teaches in the abstract that the window is moved and sized dynamically based on random numbers, etc., as further illustrated in paragraphs [0008-0015] in the specification / detailed description where the first and second windows can each contain various images or similar and move around all over the screen, which is the teaching of the this claim, basically that a second

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window is moved around a first window based on a determining means, as recited in the specification that would contain a random number or similar.

Sumikawa clearly teaches moving a window a predetermined number of pixels or predetermined distance from another image (an icon or cursor, which could easily be another window, particularly in light of the teaching of Dimitrova).

The three references are obviously directed to the same problem solving area, that of positioning a window on a monitor with a second window and also are analogous art, as they both move a window automatically based on how the computer program instructs them to do, based on (in the case of Dimitrova) characteristics of the video (e.g. motion, texture, etc.) or random numbers (Abe).

While reference Dimitrova teaches all of the limitations as set forth above, since the claim recites 'means' the Abe reference is incorporated because it performs essentially the same tasks, but under automatic program control rather than the user performing such a task, and obviously the techniques that allow the system of Abe to automatically resize and reposition windows could be used with the system of Ward such that the windows (e.g. main guide window and the PIP window) are resized, repositioned, etc. automatically until the user sees a combination that is ideal for their tastes and preferences. Obviously, resizing the window would be an obvious variation, and the motivation for combination comes from the fact that an automatic method of performing a manual task is more efficient and more likely to quickly generate the desired results for the user than manually incrementing each window, which is obviously a tedious process, and the system of Abe would be ideal for situations where only part of the video was

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moving, e.g. two persons sitting at dinner table and the window could be randomly positioned in one of many areas of low activity around the edge of the screen as Dimitrova does (1:40-2:6).

Furthermore, if the user were operating the screen, and the secondary window were an OSD of functions for controlling the display device (as is typical), one would not want this overlapping the main window. This scenario is certainly one similar to that envisioned by Sumikawa – see for example Figure 4, 4:35-5:5, and the like, where the secondary window is kept within some distance of the location where the user's attention is focused, e.g. the system has a cursor or pointing device or some other indicator or user's attention. Dimitrova would therefore be modified in light of Sumikawa to keep the other window or edit menu or the like within a certain distance of the main window but out of the way so that the user could easily access it without impeding operations.

The recited 'icon image' is not specifically defined by the specification and could be an OSD control menu, advertising, a window containing user tools (e.g. as in Sumikawa Figure 4C), or anything else. Examiner is interpreting it as broadly as reasonable (In re Morris).

As to claims 2 and 10, the Dimitrova reference is 1:5-37 emphasizes that the PIP signal can be turned off (1:5-15), which would constitute "instruction means" for turning on or displaying the second image; Abe clearly performs this task in [0018] where it states that after a certain amount of time, if it does not get an input, it then in [0019] generates the first window and then the second window

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and moves it around [0019-0020] as per computer program [0030-0031], which clearly qualifies as instruction means. The initial position of the object (if it is an animation, etc.) is set by the computer program [0008], [0019-0021], and [0029-0031], which then causes the determining means to display the second window only when the conditions (e.g. a fixed time with no user input exceeded) has occurred or when the user instructs the TV to turn on the PIP image. Motivation and combination is taken from the parent claim.

As to claim 3, as shown in Fig. 4 Dimitrova repositions the image [1:40-2:10] in areas of low activity or change on the main screen, which is "arbitrary" and Abe changes the location as based on a random number (see "Constitution" section of the Abstract for example). Motivation and combination is taken from the parent claim.

As to claims 4 and 12, Dimitrova does expressly teach this limitation. Reference Abe teaches in the Abstract that the image is moved around based on random numbers, where in [0008-0009] it is stated that the conventional screen saver would be confined to one region of the screen and still would cause burn-in ("seizure of screen" is the terminology the Japanese translation uses) of the CRT, thusly in [0013-0015] it is stated that the second image (e.g. the moving one as shown in Fig. 1) moves all over the screen and never stays beyond a fixed time to prevent burn-in. Obviously, this is the case where a minimum time is not exceeded. Given that the stated goal of Abe is to avoid the problem of excessive residence time of the screen saver image on any portion of the screen so as to avoid burn-in, obviously the system of Abe will keep the image in any

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one part of the screen a minimum amount of required time. Reference Dimitrova does state that the PIP region is moved around the screen based on activity, e.g. it is moved to areas of the screen that show the least amount of change so as to avoid obscuring important regions in the main window. Obviously, this technique could be utilized by Abe so that the system would move the window randomly to areas of the screen with little or no change (in an all-black window (Abe [0014-0015]) that would be most of the screen such that it would stay a minimum of time in any one part of the screen and would not exceed residence times anywhere on the screen). Motivation and combination are taken from the parent claim.

As to claim 5, obviously the Dimitrova reference generates a second image (e.g. the PIP video window) and displays it. However, it is unknown whether this is the intention of applicant. As such, the Abe reference clearly can generate arbitrary images or animations, for example the fish cited in [0008] and shown in Drawings 3 and 7, see elements 42 and 61 in Drawing 3 specifically. Obviously, in either or both cases, there is an "image generation means" that generates and displays the fish animation, such that it moves around the screen and is so moved by the determining means. Obviously, such windows are superimposed as in Drawings 3 and 7 of Abe where one window moves around inside of another, and the Dimitrova reference moves the smaller PIP video window around inside the main video image as recited. Motivation and combination are taken from the parent claim. Further, in Sumikawa the secondary window and cursor are both superimposed on the main screen.

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As to claim 7, clearly Abe teaches that the second image that is moved around the screen is resized randomly (see Drawings 1-2); obviously this encompasses "image size conversion means". Further, the system of Dimitrova is known to resize the PIP window as discussed at length above (see Fig. 4, steps 116 and 130) and it is known to let the user resize it as well 1:5-35. Motivation and combination is taken from the parent claim. Also, Dimitrova clearly teaches that the user can adjust the size of the PIP window, which is superimposed.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dimitrova in view of Sumikawa and Abe as applied to claim 5 above, and further in view of Ward.

The Dimitrova and Abe references do not expressly teach this limitation, while Abe teaches the generation of arbitrary animations and screen savers, which could obviously be icons. The Ward reference specifically (see Fig. 1) teaches the use of icons, menus, and other such items in various windows in [0030, 0171-0173] that can be made transparent and/or translucent to the degree desired by the user, and teaches multiple windows (see the first rejection under 103(a) above for details on this particular point). Obviously, it would have been obvious to display the content of Ward in the PIP windows of Dimitrova or the second window / screen saver of Abe or the secondary window of Sumikawa, given that Dimitrova also teaches transparency (3:13-35) and Fig. 3 where the

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PIP transparency adjuster 62 is shown and in Figure 4 where the step of adjusting PIP transparency 110 is shown).

The Abe and Dimitrova references do not expressly teach this limitation, while the Ward reference does. Multiple windows can be repositioned and resized by the user. Obviously, any of those could be the recited "first window" and "second window" and obviously Abe and Dimitrova teach the moving and resizing of a PIP window, and the Ward reference teaches such a PIP as well as other windows for advertising, TV Guides, etc. Motivation and combination is taken from claim 6.

Conclusion

This is a RCE of applicant's earlier Application. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory

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period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Woods whose telephone number is 571-272-7775. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ulka Chauhan can be reached on 571-272-7782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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